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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,654	07/10/2006	Tetsuya Okano	0425-1218PUS1	5662

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EXAMINER	
FISHER, ABIGAIL L	
ART UNIT	**PAPER NUMBER**
1616	

NOTIFICATION DATE	DELIVERY MODE
06/30/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/551,654	**Applicant(s)** OKANO ET AL.	
	Examiner ABIGAIL FISHER	**Art Unit** 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Mina Haghighatian/
Primary Examiner, Art Unit 1616

Continuation of 11. does NOT place the application in condition for allowance because: The rejections are maintained for the reasons set forth in the Final Office action mailed on 3/18/09. Applicants argue that (1) Tamura et al. fails to disclose the two step pH adjustment as disclosed in the present invention and thereby fails to disclose an organic peracid obtained at a pH of 8 to 12. Applicants argue that (2) Kobayashi et al. fails to disclose adjusting the pH to 1 to 5. Applicants argue that it is contrary to common knowledge to adjust the pH of the bleaching composition to an acidic region from the alkaline region. Applicants argue that (3) the specification shows compositions of the instant invention with that of the closest comparative prior art and that this provides the distinction of the instant invention over that of the prior art.

Regarding applicants first argument, example 1 of Tamura et al. indicates that the pH of the composition was adjusted to 2 with sulfuric acid. Therefore, the pH prior to adjustment would necessarily be above 2 as the sulfuric, because of the sheer nature that it is an acid is utilized to make the composition acidic which is a lower pH. Therefore, Tamura et al. is silent as to the pH prior to adjustment. However, this teaching would indicate a two step pH adjustment as the pH prior to addition of the sulfuric acid is higher than before addition of the sulfuric acid. Additionally, the instant claims are directed to a product by process. **Note MPEP 2113 [R-1]** "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The MPEP also indicates that "the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). The resulting product of Tamura et al. is one which posses a pH value of 1 to 5 and comprises water and an organic peracid. Therefore, the product of Tamura et al. is the same as instantly claimed. Applicants must demonstrate that the resulting products are different.

Regarding applicants second argument, while it is true that Kobayshi et al fails to disclose adjusting the pH to the acidic region, Kobayshi et al. teaches that the alkaline region is utilized to activate the triacetin and hydrogen peroxide. However, comparative example 4 of Kobayshi et al. shows that maintaining the pH in this region results in a substantial reduction of the bleaching rate. However, Tamura et al. teaches that the adjustment of the composition to a pH in the acidic region results in a more stable composition. Therefore, at least Tamura et al. recognizes that the composition in the acidic region.

Regarding applicants third argument, Comparative example 5.5 to example 5.2 wherein the only difference is the pH shows that the lower pH composition retains more of the organic peracid and degree of remaining hydrogen peroxide, however this would be expected based on the teachings of Tamura et al. As indicated above the instant claims are directed to a product by process, the invention of Tamura et al. comprises the same ingredients at the same claimed pH. Applicants must demonstrate that the product obtained by the instant process results in a different product than the resulting product of Tamura et al.